

REMARKS

The accompanying Declaration of Wade Lee Under 37 CFR 1.132 is submitted to provide evidentiary substantiation of the various factual arguments presented in the previous responses and to place the case in better condition for appeal. In addition, the Declaration of Lee provides further exhibits, not previously referenced in the earlier responses, which evidence the widespread use of prior art halogen worklights subject to the problem addressed by applicant's invention. These exhibits, the testimony of Mr. Lee, and the exhibits and remarks of the earlier responses show the long-existing nature of the hot-worklight-surface problem throughout the industry. Specifically, the Declaration includes as additional exhibits printouts from The Home Depot, Sears and Lowe's web sites showing the range of halogen worklights offered by these companies. The Home Depot, Sears and Lowe's were selected because these are the largest Home Center and Do-It-Yourself retailers in the country collectively offering halogen worklights at, literally, thousands of stores as well as on the web. In addition, a printout is included for The Designers' Edge, which describes itself as "an international manufacturer and marketer of worklights" and other lighting products, and as "North America's fastest growing worklight and security lighting supplier," and as "the world leader of portable worklights." (See the company profile on the company's web site.) These exhibits focus on halogen worklights because halogen worklights get very hot and so are the kind of worklights called for in the preamble of applicant's claims. (Note that printouts are provided only for the Designers Edge halogen worklight series and not the fluorescent worklight series, because the fluorescents do not get hot as called for by the claims.)

These exhibits, the facts established in the Declaration of Lee, and other exhibits submitted previously all address important evidence of nonobviousness—namely, the long-existing hot-surface problem and the widespread industry reliance on the printed warning label as the accepted viable way to deal with the problem.

Why does this response discuss right up front the evidence of a long-existing, widespread problem and the industry's response to that problem? Because the Examiner has completely ignored such evidence, and that is legal error.

The courts have repeatedly held that the so-called objective considerations of nonobviousness must be considered whenever they are present. The Federal Circuit has even commented that objective considerations, such as failure of others... "may often be the most probative and cogent evidence" of nonobviousness. Advanced Display Systems, Inc. v. Kent State Univ., 212 F.3d 1272, 1285, 54 USPQ2d 1673 (Fed. Cir. 2000), quoting Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983). The objective considerations are not just secondary evidence to be looked at in close cases. The objective considerations **must** be considered whenever they are present along with the other *Graham* factors for analyzing nonobviousness.

The objective considerations were discussed at length in the responses of November 19 and December 9, 2002. Those considerations along with the further support submitted with this response (Declaration of Lee and attachments) overcome any asserted *prima facie* case of obviousness that the cited references may raise. The Examiner has completely ignored this important evidence that refutes the Examiner's assertion of nonobviousness based only on the cited references.

Thus, applicant offers three separate arguments why the pending claims are nonobvious. First, regardless of whether the cited references establish a *prima facie* case of nonobviousness, the submitted evidence of objective considerations refutes that *prima facie* case. Second, the Examiner's asserted *prima facie* case is based on a false reading of the teachings of the Parker reference. As explained below and in applicant's previous responses, Parker's teachings of liquid crystal thermometers does not directly apply to applicant's worklight problem, and in fact the clumsy construction of a 2-inch thick moderator that Parker teaches is so impractical for worklights that it conveys the effective message to persons of routine skill in the worklight arts, "Liquid crystal thermometers are too clumsy to be useful in your problem." Third, the Examiner has not established why persons of *routine* skill in the worklight arts would ever look to liquid crystal thermometers or to thermochromics of any kind in the first place.

The undersigned takes exception with other points in the Examiner's latest office action. In paragraph 8 of the Office Action the Examiner asserts that applicant's arguments "are moot in view of the new ground(s) of rejection." This is wrong.

The Examiner had previously rejected claims 1-5, 8, 9, 11 and 12 under 103(a) as being unpatentable over the admitted prior art worklight set out in the specification in view of Parker (3,893,340) and Virnoche (339,247). (Although the rejection indicated claim 1, it was claim 13 that was intended.) The present action rejects claims 13, 2-5, 8, 9 and 11 under 103(a) as being unpatentable over the admitted prior art worklight set out in the specification in view of Parker (3,893,340). Claim 12 is presently rejected under 103(a) in view of Parker and MacDonald (3,877,411). Virnoche is cited only for its disclosure of a recessed area. The only claim that has a recessed area is claim 12. Thus, Virnoche has no relevance to the rejection of any other claim. Thus, claims 13, 2-5, 8, 9 and 11 are rejected on exactly the same grounds in both office actions, namely, obviousness in view of Parker. Not only that, the Examiner's remarks applying the Parker reference to claims 13, 2-5, 8, 9 and 11, are almost verbatim the same and point to exactly the same sections of the Parker reference for the same reasons in both office actions. When the statutory basis and the references are the same in the two office actions, then the grounds of rejection are the same. This is all the more so when the Examiner cites the same sections of the Parker reference in the two office actions. Thus, applicant's earlier arguments are not moot, as asserted by the Examiner, and must now be addressed.

As to claim 12, the undersigned asserts that the MacDonald reference is no better than Virnoche, and the same arguments as before apply. In fact, MacDonald is not a proper prior art reference because it is non-analogous art. Common sense dictates that there is no way that anyone of any level of skill in the worklight arts would have even the slightest hint that railway roller bearings would have any problem in common with worklights and that the person of ordinary skill would be well advised to look at the arts dealing with railway roller bearings for suggestions as to how to deal with hot worklights. The test for analogous art stated in *In re Wood and Eversole*, 202 USPQ 171 (CCPA 1979), requires that if the art is not in the inventor's field of endeavor (and there is no connection here with railway roller bearings), the reference be "reasonably pertinent to the particular problem with which the inventor was involved." Any pertinence here is at best remote and cannot be described as "reasonable." Where is the "reasonableness"? If the Examiner has

any doubts about this, she should attempt to enunciate for herself just what that pertinence is and why it is reasonable.

In Paragraph 9 of the office action, the Examiner misunderstands applicant's argument. The Examiner refers to applicant's statement from the earlier response:

"Parker actually teaches that there are no liquid crystal thermochromics that would be useful directly for applicant's problem because their destruct range usually has an upper limit of about 80 to 90 degrees Celsius (2:56-58) and the temperatures of interest to applicant have to go up to around 150 degrees Celsius (the UL maximum permitted temperature)."

This statement is correct. The point is that Parker's liquid crystals cannot be used *directly* in applicant's temperature range, but must be used with a thermal moderator as taught by Parker. *Direct* use means applying the liquid crystal material directly to the surface to be measured, as opposed to *indirect* use through a moderator. This is explained in the very next sentence in applicant's response following the sentence quoted by the Examiner: "Thus, *Parker* teaches that for applicant's problem one must use a thermal moderator..." To reiterate the point, Parker teaches that applicant's temperature range is beyond the destruct range for liquid crystals. Parker goes on to teach that for higher temperatures beyond the destruct range, one should use a thermal moderator, and Parker teaches that the thermal moderator has to be on the order of 2 inches thick. A 2-inch thick moderator is unworkable on worklights. So Parker effectively teaches here that if you want to use liquid crystals, you have to use a moderator that is too thick for use on worklights. There is no way that the person of *routine* skill in the worklight arts would successfully apply the teachings of Parker to applicant's problem. This is assuming for the sake of argument that there would be some suggestion to persons of ordinary skill in applicant's art to look to thermochromics to begin with.

Paragraph 10 of the office action shows another misunderstanding. The features referred to (thickness of the moderator, etc.) are not intended to be limitations of the claims. These features were not discussed in the context of distinguishing applicant's invention from the prior art. They were raised to point out what one of ordinary skill in applicant's art would learn from the asserted prior art reference (Parker), assuming that one in applicant's art would ever be motivated to look at the Parker reference.

The undersigned asserts that all the pending claims are allowable.

Respectfully submitted,



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